

REMARKS

Claims 1-22 are pending.

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hyllander et al. (WO 99/12365) (Hyllander) and Mullender (Distributed Systems, Second Edition).

In response to the Office Action of October 22, 2004, applicant filed an amendment on March 21, 2005 amending claims 1, 2 and 14 by adding a limitation, i.e., "wherein the piece of call identifying information is information to judge whether the call from the terminal is incorrect or not, and when said control unit can not receive the first address information corresponding to the call identifying information from the server, said control unit does not respond to the call assuming that the call is incorrect."

However, the Examiner disagreed with the presented arguments with regard to overcoming the rejections. Therefore, those amendments have been removed in this response.

Reconsideration of this application is respectfully requested for at least the following remarks in sections 1, 2 and 3.

1)

Applicant's claims 1, 2 and 14 include generating, when receiving a piece of first address information as a piece of address information of a call destination of a speech communication from a terminal device, a piece of call identifying information corresponding to the first address information. Because of applicant's claimed feature of generating the call identifying information advantages are obtained as pointed out below which cannot be achieved by Hyllander.

It's admitted in the Office Action that none of the references show this feature. It is simply argued that since Hyllander describes knowing the caller number and the internet address of the callee this meets the limitation.

Applicant respectfully disagrees for several reason including that the MPEP 2143 requires to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

This rejection fails on all three of the tests. First the references do not teach all the limitations as admitted in the Office Action. There is no teaching of the feature of generating the call identifying information. This is admitted in the Office Action.

Second the Office Action purports to modify applicant's claimed invention to fit the cited reference (changing applicant's generating to knowing the caller number). But the Office Action fails to point out where there is any motivation to make such a modification. Applicant respectfully submits there is no motivation and applicant's own disclosure is being used as a road map in order to make this rejection.

Third there is no teaching anywhere that there would be a reasonable expectation of successfully modifying the teaching of the cited reference. Again only applicant's disclosure is being used to provide such a road map of success.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Neither is found in the references. In this case applicant's own disclosure is the only teaching which provides for any of the suggestion and expectation of success.

As pointed out below there are reasons why it would not be obvious to use the caller number compared to applicant's claimed invention and advantages gained by applicant's claimed invention. The invention of Hyllander does not need the call identifying information due to the aim of the invention of Hyllander, on the other hand, applicant's claimed invention recites the generating of the call identifying information due to the aim of the claimed invention.

It is respectfully submitted that the technology of the call identifying information is not simply arrived by using the invention of Hyllander due to the differences and advantages applicant's claimed invention provides as pointed out by the below examples. Therefore, claims 1, 2 and 14 are nontrivial and the rejection should be withdrawn.

2)

Applicant claims a module of the server notifying said terminal device of the call identifying information and second address information as a piece of address information of said control unit.

Now in the Office Action the call identifying information is being equated to "call status."

First it is improper to mix and match elements to fit into a rejection. In one place the call identifying information is being equated to the caller's number. Now it is being equated to "call status" whereas previously it was equated to the caller number in Hyllander.

Second there is no "call status" discussed in the reference, particularly at the pointed to page 14, lines 1-3 only that a connection is possible. The reference does not describe the server notifying said terminal device of call status and second address information as a piece of address information of said control unit.

Third, even considering that the call identifying information as previously equated with the caller telephone number, there is no description in the reference of the server sending back the caller's telephone number back to the caller.

It is respectfully submitted that the prior art reference (or references when combined) fail to teach or suggest all the claimed limitations and the rejection should be withdrawn.

3)

a) Examples of differences of the invention of Hyllander and advantages of applicant's claimed call identifying information

There are differences between applicant's claimed invention and the invention of Hyllander for identifying a call.

Applicant's claimed invention uses the call identifying information. In contrast, the invention of Hyllander uses the caller number instead of the call identifying information.

Because of applicant's claimed invention it is possible to identify multiple calls from one terminal at the same time since applicants have a call identifying information (detailed below).

In contrast Hyllander only identifies the callers number and cannot distinguish between two calls from the same terminal.

Also applicant's claimed invention makes it possible to use the call identifying information as an evidence in which a condition is satisfied. For example user authentication or suppose the caller terminal must view an advertisement in order to gain enhanced services. The server may generate call identifying information for the caller terminal only when this is verified. In Hyllander's invention the recognizing the caller's number is completely different.

For example, when the caller's terminal connects to the server for notifying a first address information to the server, the server checks whether user authentication information from the caller's terminal is valid or not. Only when the authentication information is valid, the server generates the call identifying information. Or until the caller's terminal connects to the server and notifies the first address information to the server, by showing an advertisement from the server to users, the server generates the call identifying information for only users who have seen the advertisement.

In response to the Office Action of October 22, 2004, the advantage of preventing invalid accesses was presented. In addition as mentioned above there is an advantage of providing the guarantee that a caller's terminal has satisfied a condition such as viewing an advertisement.

The invention of Hyllander identifies the call by using the caller number, however Hyllander cannot achieve the advantages as pointed out above because Hyllander fails to teach the claimed call identifying information. Therefore, claims 1, 2 and 14 are patentably distinct.

Further details of the differences

In the invention of Hyllander, a calling address is an 'Internet address'. It appears that an 'Internet address' is a SIP address in use of VoIP.

In Hyllander, a caller's terminal does not call a calling terminal by using the Internet address directly. Therefore, Hyllander uses a 'server', which connects the server with the calling terminal by using the Internet address, in order to connect the caller's terminal with the calling terminal. More specifically, the caller's terminal sends the Internet address as a SMS message to the server, and calls the server by using the server's telephone number.

The server memorize the Internet address and the caller's telephone number into a table (memory) in the server. Then, when the server receives the call from the caller's terminal, the server searches the table to find the internet address according to the caller's telephone number, and then connects the caller's terminal with the calling terminal.

In this architecture, the server enables the caller's terminal to connect with the calling terminal although the caller's terminal does not connect with the calling terminal directly.

In contrast in an example embodiment herein, a calling address is a first address information. A caller's terminal is able to connect with a calling terminal by using the first address information directly. Although the caller's terminal is able to connect with the calling terminal by using the first address information directly, the caller's terminal calls the calling terminal through a call control unit (hereafter, comparing the claimed invention with the invention of Hyllander, a call control unit is equated as a server in this Office Action since a server for the claimed invention and a call control unit for the claimed invention may be regarded as a server for the invention of Hyllander in several cases although differences do exist) by using the second address information (the telephone number of the server).

One reason why the claimed invention has the architectures is to propose enhanced services to users. The enhanced services by the claimed invention gives discount services to users for example. In the present application, a contract with users or showing advertisement to users is

considered in order to give discount services to users. Therefore, evidence which shows that a condition is satisfied by a terminal is necessary. Only terminals that have satisfied a condition use the discount services.

As mentioned above, the invention of Hyllander does not need the call identifying information due to the aim of the invention of Hyllander, on the other hand, the claimed invention needs the call identifying information due to the aim of the present invention. Therefore, it is submitted that the technology of the call identifying information is not simply arrived by using the invention of Hyllander due to the differences between the aims. Therefore, claims 1, 2 and 14 are nontrivial.

(b) The meanings of technologies by generating and using the call identifying information

It is pointed out in the office action that it is possible for the server of applicant's claimed invention to identify the call by using the first address information (the calling number) instead of the call identifying information.

Applicant's respectfully disagree. For example, in a case that the first address information is used instead of using the call identifying information, and when a caller's terminal A and a caller's terminal B notify the same first address information (the same calling number) to the server instead of notifying the call identifying information to the server, the server is not able to identify the caller's terminal since both caller's terminals use the same information as the call identifying information.

On the other hand, considering when the caller number is used instead of the call identifying information. When the first address information a and the first address information b are sent by the caller's terminal A, the server is not able to connect the caller's terminal A with

the calling terminal since the server does not distinguish the calling terminal for the first address information **a** from the calling terminal for the first address information **b**. It is needed that the server distinguishes the calling terminal for the first address information **a** from the calling terminal for the first address information **b**.

As mentioned above, if there are plural terminals, in case that each one of plural terminals sends plural caller numbers or plural calling numbers instead of sending plural call identifying information to the server, the method which uses the caller number or the calling number is not able to identify the call.

In contrast with the call identifying information, it is possible that, even if plural first address information (for example, the first address information **a** and the first address information **b**) from a terminal are sent to the server, the server generates the different call identifying information to each one of the first address information. Therefore, the server identifies each one of the calls from the terminal.

Further, it is possible that, even if the server receives the same calling number from plural caller's terminals (for example, a caller's terminal **A** and a caller's terminal **B**), the different call identifying information corresponding to the caller's terminal **A** and the caller's terminal **B** are generated and notified by the server. Therefore, the server distinguishes the caller's terminal **A** from the caller's terminal **B** by checking the call identifying information.

Further, when receiving the call at the server, the server does not always receive the caller number in the prior art. It depends on communication systems whether the server receives the caller number or not. However, if the call identifying information is used, it is possible that the server identifies the terminal.

Therefore, at least three advantages are mentioned: (1) the advantage that, when plural first address information (plural calling numbers) are notified to the server from a caller's terminal, the server identifies each one of the plural first address information, (2) the advantage that, when the same first address information is notified to the server from plural terminals, the server identifies the plural terminals, (3) the advantage that, even if the caller number is not notified to the server in a system, the server identifies the caller's terminal by using the call identifying information. These advantages are not shown by the invention of Hyllander.

The arguments for claims 10 and 21

Claim 10 is similar to claim 21. For claims 10 and 21, the Examiner has pointed out that claims 10 and 21 are rejected for similar reasons as claims 3, 4, and 6 in the text of this office action.

The Examiner has pointed out for claims 3, 4, and 6 that "it is well known in the art for the mobile terminal device (8, fig. 2) to send its positional location to server (11, fig. 2) connected to the Internet (3, fig. 2) when requesting services from the server. Hence, it would have been obvious to one of ordinary skill in the art to allow the mobile device to inform the server of its geographical location for billing purposes and other customized products that correspond to that location such as location-specific advertisements and/or weather emergencies" in the text of this office action.

However, this office action fails to describe whether a system which has a combination of both this phone system and a advertisement system is existing or not. Applicant claims a unique combination of features which is not suggested in the prior art. Again the Office Action is using

applicant's claimed invention as a roadmap for preparing a rejection. Further, the architecture of claim 10 (claim 21) is not found in Hyllander.

As mentioned above, the call identifying information is not found nor suggested in the prior art. Therefore, claim 10 (claim 21) is not arrived by a simple combination of Hyllander and ordinary skills.

In addition by simply arguing that the features are merely ordinary skills in the art, applicant cannot judge whether any motivation exists for making such a combination since as pointed out above Hyllander fails to make such motivation or suggestion.

The arguments for claims 11 and 22

Claim 11 has a similar architecture as claim 22. The Examiner has pointed out for claims 11 and 22 that "Hyllander teaches the server transmits a request for user authentication information to said terminal device and, only when the user authentication information received from said terminal device is valid, notifies said terminal device of the call identifying information and the second address information (page 13, lines 28-29; system verifies and certifies caller's identification data before authenticating the user for service)."

However, in Hyllander (page 13, lines 28-29), it is described that the specific identify of said mobile subscriber station (for example, the telephone number of the mobile subscriber station). Therefore, the skill disclosed in Hyllander is not a skill for a usage of user authentication information described in the present application.

Applicant claims a unique combination of features which is not suggested in the prior art. Again the Office Action is using applicant's claimed invention as a roadmap for preparing a rejection. Further, the architecture of claim 11 (claim 22) is not found in Hyllander. The call

identifying information is not found nor suggested in the prior art. Therefore, claim 11 (claim 22) is not arrived by a simple combination of Hyllander and ordinary skills.

SUMMARY

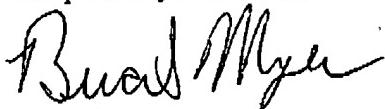
Claims 1-22 stand rejected as being unpatentable over Hyllander and Mullender. To be properly rejected, each and every element of the claims must be addressed through known prior art or be recognized as an obvious variation thereof. Applicant contends that the combination of references, or obvious variations in the teachings of the combination of references, fail to provide for many of the limitations of applicant's claimed invention.

The above-mentioned arguments with respect to independent claims 1, 2, and 14 substantially apply to dependent claims 3-13 and 15-22 as they inherit all the limitations of the claim from which they depend.

It is respectfully submitted that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicant's representative at the below number.

Respectfully submitted,



Brian S. Myers
Reg. No. 46,947

CUSTOMER NUMBER 026304
Telephone: (212) 940-8703
Fax: (212) 940-8986/8987
Docket No.: FUJY 18.878 (100794-00127)
BSM:fd